REMARKS

This paper is filed in response to the office action mailed on February 7, 2006. Claims 1 and 21 have been amended; and claims 28-31 have been added. Claims 1-12 and 17-31 are pending and at issue. The previous prior art rejections have been removed by the Examiner.

The office action nevertheless rejects claims 1-12 and 17-27 under one of two prior-art rejections. First, claims 1-12, 17-20, and 24-27 stand rejected as obvious based on a suggested combination of DeBan et al., Yoshida et al., and Alden. Second, claims 21-23 stand rejected as obvious based on a suggested combination of DeBan et al. and Colbert. These rejections have been carefully considered and are respectfully traversed for the reasons outlined below.

Claim 1 stands rejected based on a suggested combination of DeBan et al. and Yoshida et al. In a previous office action, the Examiner suggested that a combination of DeBan et al. and Yoshida et al. would teach the recited subject matter. Applicants responded by noting that DeBan does not teach an ability to obtain an image of an interior of a gaming machine – a point the present office action now confirms. Applicants also noted that Yoshida, relied upon by the office action for teaching internal cameras, does not teach interior image collection automatically initiated in response to a user interacting with a peripheral on the gaming machine. In fact, it was noted that Yoshida requires the detection of fault information, the communication of that fault information to a remote supervising controller, who then must determine the kind of fault before sending a remote command to the ATM for camera initiation. See, e.g., Yoshida 3:41 – 4:8, and Fig. 3. Thus, it has already been shown the DeBan et al. and Yoshida et al. do not teach the recitation directed to the interior surveillance capability. For this reason alone, the rejection of claim 1 is improper and should be withdrawn.

Nevertheless, applicants have amended claim 1 to include the capability of obtaining an interior image in response to a peripheral of a gaming machine as well simultaneously with the obtaining of the current facial image information of the user. Claim 1 has been amended to recite "wherein the at least one image collection device is also for obtaining the at least one image of the activity associated with the interior of the gaming machine simultaneously with the obtaining of the current facial image information."

None of the prior art teaches such a combination of elements, and there is no suggestion or motivation to combine the prior art teachings to develop such dual image gathering capability in a gaming machine. The office action does reject claim 24, which recites simultaneously obtaining a current facial image and an activity associated with an interior of a gaming machine. But in that rejection the office action concedes that none of the prior art individually teaches this simultaneous operation. Instead, the office action states the following:

> In addition, it is not specifically disclosed [in DeBan] that there is a method of providing at least one image collection device for obtaining at least one image of an activity associated with the interior of the gaming machine. Yoshida et al teaches several cameras associated with the interior of an ATM machine, where the machines taught by Yoshida et al and DeBan at al are both capable of synchronizing their efforts as one machine to simultaneously obtain images of an activity associated with the interior of the gaming machine and get a facial image comparison.

The office action does not point to anything in the prior art as suggesting the claimed subject matter, only a belief that the claimed subject matter was a capability based on the prior art. The office action concludes that although neither DeBan et al. nor Yoshida et al. individually teach or suggest simultaneous operation between an exterior and an interior image capture device, somehow the two when combined would teach such subject matter.

Applicants respectfully, but strongly disagree with this rejection. The MPEP boldly sets forth that the "mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination." MPEP s 2143.01, III, citing In re Mills, 916 F.2d 680 (Fed. Cir. 1990) (Emphasis added). Therefore, whether Yoshida et al. and DeBan et al. are "capable of synchronizing their efforts" (assuming for argument this is the case) does not meet the examiner's burden of establish *prima facie* obviousness of the claimed subject matter.

If mere capability were the test for patentability, then a great many inventions would have never been patented, because technically speaking even before the moment of conception, there existed the possibility of it. As explained by the Federal Circuit in In re Rouffet:

> As this court has stated, "virtually all [inventions] are combinations of old elements." Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue...To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.
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> In re Rouffet, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998) (citations omitted and emphasis added).

The office Action points to no teaching, suggestion, or motivation from the prior art for achieving simultaneous interior and exterior imaging in a gaming machine. In fact, Yoshida et al. teaches away from such a configuration, and would appear to be rendered inoperable by such a configuration, because Yoshida et al. relies upon remote activation of its interior camera, not local triggering. This remote triggering may be done in part to reduce the amount of recording media needed for otherwise constantly imaging the interior of a device, a problem noted in the specification. It may also be done to prevent the unnecessary manpower needed to keep watch over an interior camera that is always operating. In any case, it cannot be argued that Yoshida et al., the only reference teaching internal cameras, would be modified to provide synchronous operation with an external camera, because Yoshida et al.'s camera operation is for the purpose of providing supervision when a fault event occurs, thus teaching away from being combined into a system that uses internal cameras in the potentially continuous manner of simultaneous operation with an external camera.

The rejection of claim 1 and the rejections of claims 2-12 and 17-20 depending therefrom are respectfully traversed.

For similar reasons, the rejection of independent claim 24 and the rejection of claims 25-27 depending therefrom are also traversed. Reconsideration is respectfully requested.

Claim 21 stands rejected based on a suggested combination of DeBan et al. with Colbert. The office action concedes that DeBan et al. does not teach a device that attempts to obtain current facial image information. The office action concedes that DeBan et al. does not teach comparing first facial image information with current facial

image information. Yet despite recognizing these shortcomings in the teachings of DeBan et al., the office action concludes that these recitations are taught because in the office action's view DeBan et al. is "capable" of achieving these recitations. As noted above this is **not** a legally permissible ground to reject a claim as obvious.

The office action also concedes that the DeBan et al. does not teach generating security data indicating an alarm condition when the gaming machine is unable to capture current facial image information, such as in the "black out" condition discussed in the specification. Claim 21 has been amended to further recite communicating that security data indicating an alarm condition to a remote location, which is taught by neither DeBan et al. nor Colbert.

The rejection of claim 21 and the rejections of claims 22 and 23 depending therefrom are respectfully traversed.

Applicants have added independent claim 28 by amendment above. The claim is similar to claims discussed above with multiple facial image information being obtained, yet in contrast generally recites a method of authorizing a payout to a user of a gaming machine by comparing a first facial image information to a second facial image information. For example, the image of a player may be obtained from that player's card and then when a winning payout event occurs during the game, another image of that player may be taken for comparison to the image on the card to verify that the player has not changed since the game was initiated. Specifically, claim 28 recites:

> 28. A method of authorizing payout to a user using a gaming machine located in a casino, the method comprising:
>
> in response to an initial trigger event occurring prior to or upon initiation of a game on the gaming machine, obtaining first facial image information regarding the user at the gaming machine;
>
> in response to a second trigger event occurring during execution of the game on the gaming machine, obtaining second facial image information of the user at said gaming machine; and
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> comparing said first facial image information with said second facial image information of said user at said gaming machine to confirm that the user using the gaming machine during the first trigger event is the same user using the gaming machine during the second trigger event.

Dependent claims 29-31 recite further limitations.

None of the prior art of record, whether taken alone or in combination, teaches the subject matter of claims 28-31.

In view of the above amendment, applicants believe the pending application is in condition for allowance.

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Respectfully submitted,

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